



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,152	07/19/2001	Max P. McDaniel	33633US1	1935

35395 7590 11/25/2003

JOHN S. PRATT
KILPATRICK STOCKTON LLP (CHEVRON)
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

RABAGO, ROBERTO

ART UNIT PAPER NUMBER

1713

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,152

Applicant(s)

MCDANIEL ET AL.

Examiner

Rob Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,26-45 and 50-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 and 44 is/are allowed.
- 6) ☒ Claim(s) 8,26-38,40-42,45 and 50-54 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2003 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on 7/30/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,316,553 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

3. The amendment to the abstract filed 7/19/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "at least one organometal compound" and "at least one organoaluminum compound". The

Art Unit: 1713

lengthy specification has been reviewed, but no disclosure of a polymerization process which includes more than one organometal compound or more than one organoaluminum compound can be found in the specification as filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8, 26-38, 45 and 50-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) In claims 8, 38 and 50 (and all claims dependent thereon), the phrases "at least one organometal compound" and "mixtures thereof" (as pertaining to the organometal compound) are deemed to be new matter. The lengthy specification has been reviewed, but no disclosure of a polymerization process which includes more than one metallocene or organometal compound can be found in the specification as filed.

(b) In claims 8, 38, 40 and 51 (and all claims dependent thereon), the phrases "at least one organoaluminum compound" and "mixtures thereof" (as pertaining to the

Art Unit: 1713

organoaluminum compound) are deemed to be new matter. The lengthy specification has been reviewed, but no disclosure of a polymerization process which includes more than one organoaluminum compound can be found in the specification as filed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Soga et al. (Makromol. Chem. 1993).

The reference discloses a method of ethylene polymerization comprising a supported catalyst made by a process comprising: (i) calcining silica, (ii) contacting the calcined silica with dichlorodimethylsilane, and (iii) contacting the treated silica with dicyclopentadienyl zirconium dichloride, and (iv) contacting the composition with triisobutylaluminum, and therefore contains all claimed limitations (see page 3500 through pg. 3501, Table 1). In view of the open-ended wording of the claim (i.e., "comprising") the additional process steps specified in the reference are not excluded from the specified method of making the catalyst of the claims.

Art Unit: 1713

8. Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Inatomi et al. (EP 628 574).

The reference discloses a method of propylene polymerization comprising a supported catalyst made by a process comprising: (i) contacting alumina with ammonium fluoride (ii) calcining the treated alumina (iii) contacting with ethylene-bisindenyl zirconium dichloride, and (iv) contacting the composition with triisobutylaluminum, and therefore contains all claimed limitations (see page col. 9, lines 1-38). The reference process differs from the product-by-process steps set forth in the claims in that no calcining step is specified prior to contact with the fluoriding agent. However, there is nothing on this record which would indicate that such an additional step would make any difference in the final catalyst. In view of the open-ended wording of the claim (i.e., "comprising") the additional process steps specified in the reference are not excluded from the specified method of making the catalyst of the claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inatomi et al. (EP 628 574).

The parent claim is discussed with respect to this reference above. The only components missing from the cited example is the use of bis(n-butylcyclopentadienyl) zirconium dichloride and the use of a chloriding agent instead of a fluoriding agent. However, the reference suggests the required metallocene species at col. 3, line 39, and numerous chloriding agents at col. 7, lines 24-31, and therefore one of ordinary skill in the art would be motivated to use the disclosed method with these alternative components, with reasonable success expected.

Allowable Subject Matter

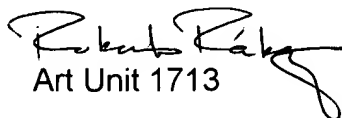
11. Claims 39 and 44 are allowed. Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 8:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ROBERTO RABAGO
PATENT EXAMINER


Art Unit 1713

RR
November 20, 2003